

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte RONALD A. SCHACHAR

Appeal No. 2005-0076  
Application No. 09/589,626

MAILED

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

ON BRIEF

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Ronald A. Schachar appeals from the final rejection of claims 1 through 21. Claims 22 through 24, the only other claims pending in the application, stand allowed.

THE INVENTION

The invention relates to a prosthetic device for treating presbyopia. Representative claim 1 reads as follows:

1. A prosthesis that contacts the sclera of an eyeball, said prosthesis comprising a body having a first end and a second end, said body having a planform that expands said contacted sclera to increase the effective working distance of the ciliary muscle of the eyeball.

THE REJECTIONS

Claims 1 through 21 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1 through 7 and 12 through 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,354,331 to Schachar.

Claims 8 through 11 and 18 through 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schachar.

Attention is directed to the main and reply briefs (filed December 23, 2003 and May 13, 2004) and to the final rejection and answer (mailed August 14, 2003 and March 9, 2004) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 101 rejection of claims 1 through 21 as being directed to non-statutory subject matter

The examiner, citing MPEP § 2105 and the 1987 Official Gazette Notice entitled "Animals-Patentability" (1077 O.G. 24),<sup>1</sup> considers claims 1 through 21 to be directed to non-statutory subject matter because they include within their scope a human being. By way of example, the examiner points to the language in

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<sup>1</sup> A copy of the notice is appended to the answer.

claim 1 reciting a prosthesis "that contacts the sclera of an eyeball."

The appellant agrees that a claim directed to or covering a human being would be non-statutory under § 101, but insists that claims 1 through 21 are directed to a prosthesis per se, not a prosthesis in combination with a human being or any part thereof.

A fair reading of claims 1 through 21 supports the appellant's construction. These claims define a prosthesis per se, and the language therein referring to the sclera and other parts of the human eye merely sets forth the environment in which the claimed prosthesis is intended to be used.

Accordingly, we shall not sustain the standing 35 U.S.C. § 101 rejection of claims 1 through 21 as being directed to non-statutory subject matter.

II. The 35 U.S.C. § 102(b) rejection of claims 1 through 7 and 12 through 17 as being anticipated by Schachar

The Schachar patent discloses a prosthetic scleral expansion band for treating presbyopia by increasing the effective working range of the ciliary muscle. Figures 1 through 5, Figures 6 and 7 and Figures 8 and 9 respectively illustrate different embodiments of the expansion band. Each embodies a one-piece circular structure. Schachar teaches, however, that

[t]he scleral expansion band may also be made in a plurality of parts that can be assembled prior to use or may be installed separately to form a complete band. The band may be adjustable in circumference. For example the band may be formed from a strip of material, e.g., metal or synthetic resin, with overlapping ends so that the ends may slide past one another thereby adjusting the circumference of the band. The length of the overlap may be adjusted, for example, by means of a tangential screw mechanism to adjust the circumference of the band and thereby the amount by which the sclera is expanded [column 7, lines 1 through 12].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

In the examiner's view, Schachar's unillustrated scleral expansion band formed from a strip of material having adjustable overlapping ends responds to all of the limitations in claim 1.

The appellant counters that anticipation does not lie because this unillustrated embodiment lacks a first end and a second end as recited in the claim. In this regard, the appellant submits (1) that the claim, properly construed, requires the first and second ends to be free and/or unattached, and (2) that the overlapping ends of the Schachar band effectively cease to exist when the band is formed because they are attached and fastened together.

It is well settled that during patent examination claims are to be given their broadest reasonable interpretation consistent with the underlying specification without reading limitations from the specification into the claims. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In the present case, the recitation in claim 1 that the prosthesis body has a first end and a second end is extremely broad. The claim neither requires the first and second ends to be free and/or unattached nor excludes these ends from being fastened or attached. The appellant's argument to the contrary rests on an improper attempt to read limitations from the specification into the claim.

Thus, the appellant's position that the subject matter recited in claim 1 distinguishes over that disclosed by Schachar is not persuasive. We shall therefore sustain the standing 35

U.S.C. § 102(b) rejection of claim 1 as being anticipated by Schachar.

We also shall sustain the standing 35 U.S.C. § 102(b) rejection of claims 2 through 7 and 12 through 17 as being anticipated by Schachar. As the appellant has not argued separately the patentability of claims 1 through 7 and 12 through 17 apart from one another, claims 2 through 7 and 12 through 17 stand or fall with representative claim 1 (In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

III. The 35 U.S.C. § 103(a) rejection of claims 8 through 11 and 18 through 21 as being unpatentable over Schachar

Claims 8 through 11 and 18 through 21 variously recite that at least one of the first and second prosthesis body ends has a top or bottom surface which is partially concave or convex. Implicitly conceding that Schachar does not disclose these features, the examiner nonetheless concludes that the provision of same to Schachar's adjustable scleral expansion band would have been obvious to suitably accommodate the overlapping ends.

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may

not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id. In short, the examiner has advanced speculation and unfounded assumptions, rather than the requisite evidentiary basis, to support a conclusion that the admitted differences between the subject matter recited in claims 8 through 11 and 18 through 21 and Schachar are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 8 through 11 and 18 through 21 as being unpatentable over Schachar.

#### SUMMARY

The decision of the examiner:

- a) to reject claims 1 through 21 under 35 U.S.C. § 101 is reversed;
- b) to reject claims 1 through 7 and 12 through 17 under 35 U.S.C. § 102(b) is affirmed; and
- c) to reject claims 8 through 11 and 18 through 21 under 35 U.S.C. § 103(a) is reversed.

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AFFIRMED-IN-PART

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